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MICHAEL K. NEWELL
PATRICIA SMINIK ROGOWSKI
MARY W. BOURKE
ROBERT G. McMORROW, JR. (PA BAR)
R. ERIC HUTZ
ARTHUR G. CONNOLLY, III
WILLIAM E. MASHANE (PA BAR)
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ASHLEY I. PEZZNER
KAREN C. BIPERATO
GERARD M. O'ROURKE
FRANCIS O'GIOVANNI
SAMUEL D. BRICKLEY II
MATTHEW F. BOYER
CHRISTINE M. HANSEN

CONNOLLY BOVE LODGE & HUTZ LLP
1220 MARKET STREET
P.O. BOX 2207
WILMINGTON, DELAWARE 19899

TELEPHONE (302) 658-9141
FACSIMILE (302) 658-5614

www.cblhiaw.com

WASHINGTON OFFICE
SUITE 800
1990 M STREET NW
WASHINGTON, DC 20036-3425
TELEPHONE: (202) 331-7111
FACSIMILE: (202) 293-6229

June 27, 2003

TO: U.S. Patent and Trademark Office
Attn: F. Teskin - Group Art Unit: 1713

FROM: Ashley I. Pezzner - TELEFAX: 302 658-5614

TOTAL NUMBER OF PAGES (INCL. COVER): 6

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Diane C. Pickering
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ARTHUR G. CONNOLLY
PARTNER EMER-US

WERNER H. MLTZ
1944-1970
JANUAR D. BOVE, JR.
1949-1991

COUNSEL
CRAIG B. YOUNG (DC & VA BAR)*
WILLIAM E. LAMBERT III (PA BAR)
M. EDWARD C. ANDERSON
WAYNE C. JASCHKE (NY BAR)
WILLIAM C. BIRGMANN (PA BAR)*
SUSAN E. SHAW MCBEE (DC BAR)*

THOMAS F. POCHÉ (DC BAR)*
MICHAEL L. LOVITZ (PA BAR)

OLEH V. BILINSKY
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MICHELLE M. MAHON
CHRISTOS T. ADAMOPOULOS
MAX B. WALTON
DANIEL J. HARISON
BRIOT C. MENDELSON
AMY A. BRIDGE (MA BAR)
HELENA C. RYCHLIK
LARRY V. HUME (DC BAR)*
JOSEPH BARRERA (DC BAR)*
REDMOND L. CLEVENGER, JR.
LIZA DUMHENSCHUTZ (PA BAR)
MARK E. FREEMAN
GWENDOLYN M. LACY
BRIAN J. HARSTON (VA BAR)*
C. KEITH MCINTYRE (VA BAR)*
ZHUN LU (N.Y. BAR)
C. TODD MARKS (VA BAR)*

* RESIDENT WASHINGTON OFFICE
DELAWARE BAR UNLESS OTHERWISE
DESIGNATED)

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Date

June 27, 2003

Diane C. Pickering
J. Lynn Ferry Diane C. Pickering

ANDREAS WINTER ET AL

SERIAL NO: 08/895,950

: ART UNIT: 1713

FILED: JULY 17, 1997

: EXAMINER: TESKIN, F.

FOR: METALLOCENES CONTAINING
LIGANDS, OF 2-SUBSTITUTED
INDENYL DERIVATIVES, PROCESS
FOR THEIR PREPARATION, AND
THEIR USE AS CATALYSTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMUNICATION

Sir:

Applicants hereby attach a copy of a Decision showing that U.S. Patent 5,276,208 was reinstated as of April 3, 2003.

No fees are believed to be due with the filing of this communication. If there are any fees due in connection with this filing, the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

Respectfully submitted,

CONNOLLY BOVE LODGE & HUTZ LLP

By *Ashley I. Pezzner*
Ashley I. Pezzner
Registration No. 35,646
Telephone: 302-888-6270

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Paper No. 41

THOMAS M. MESHBESHER
CONNOLLY & HUTZ
PO BOX 2207
WILMINGTON, DE 19899-2207

In re Reissue Patent No. RE37,208
Issued: June 5, 2001
Reissue Application No. 08/324,260
Filed: October 17, 1994
Original Patent No. 5,276,208
Issued: January 4, 1994
Original Application No. 07/419,212
Filed: November 8, 1991
Attorney Docket No. HOE-90/F-333

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OFFICE OF PETITIONS

ON PETITIONS

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This decision concerns the October 23, 2002 "Petition under 37 CFR 1.182 (or Alternatively under 37 CFR 1.378)," which is being properly treated as a petition under 37 CFR 1.377 to record a previously offered maintenance fee payment for the above-referenced patent; and, alternatively, petitions to reinstate the patent under 37 CFR 1.378(b), and in turn, 37 CFR 1.378(c).

The petition under 37 CFR 1.377 is DISMISSED.
The alternative petition under 37 CFR 1.378(b) is DISMISSED.
The alternative petition under 37 CFR 1.378(c) is GRANTED.

The original patent, No. 5,276,208, was reissued as Patent No. RE37,208 on June 5, 2001.

The second maintenance fee for the patent could have been paid from January 4, 2001 to July 4, 2001, or with a surcharge during the grace period July 5, 2001 through January 4, 2002. The fee was not paid on or before January 4, 2002. The patent expired as of January 5, 2002.

Petition under 37 CFR 1.377

The petition asserts that the fee had been offered on June 29, 2001, subsequent to the issuance of the reissue patent, but was refused by the PTO because the fee authorization mailed on June 29, 2001 included the original patent number rather than that of the reissue patent. The petition also refers to a statement, allegedly provided over the telephone by a PTO Maintenance Fee Branch employee, that "the matter was taken care of and no additional steps would be required to ensure payment of the maintenance fee for the subject patent."

Unfortunately, in short of any relevant evidence in writing, the instant §1.377 petition is based merely on hearsay and is subject to dismissal, rendering the patent expired effective January 5, 2002.

Alternative petition under 37 CFR 1.378(b)

Although the current patent statute requires maintenance fee payments at 3½, 7½, and 11½ years

Affidavit of Linda J. Hoggarth, page 2, top 4 lines.

Reissue Patent No. RE37,208

after a patent is granted in order to maintain the patent in force,² the statute also authorizes the Director of the PTO to accept a delayed payment of such a maintenance fee if the delay can be shown to the satisfaction of the Director to have been "unavoidable."³

To ascertain that such a delay is indeed "unavoidable" within the meaning of 37 CFR 1.378(b), the PTO requires proof that the party responsible for paying the maintenance fee has exercised the diligence of a reasonably prudent person⁴ in relation to his most important business.⁵ In other words, the petition must show:⁶ that reasonable measures for ensuring proper maintenance of the patent had been taken by the responsible party, but the patent expired notwithstanding such measures; efforts to seek reinstatement of the patent after discovery of its expired status; and that the entire delay⁷ in paying the fee was unavoidable.

The petition and the accompanying affidavit by a Linda J. Hoggarth in essence set forth that:

- (1) A "BASF Corporation" ("BASF") is the current assignee of the entire interest in the instant reissue patent.
- (2) 6/29/01: Linda J. Hoggarth ("Hoggarth"), the person in charge of paying patent maintenance fees at BASF, mailed the maintenance fee authorization that contained the number of the original patent.
- (3) 7/27/01: PTO Notice of Non-Acceptance of Patent Maintenance fee was mailed, informing BASF that the maintenance fee payment offered for the original patent was refused, and that the payment must be submitted under the reissue patent number and the reissue application serial number.
- (4) 9/20/02: Hoggarth received a telefax from the parent company of BASF, stating that it had received a maintenance fee reminder for this patent.⁸

² 35 U.S.C. 41(b).

³ 35 U.S.C. 41(c)(1); Laerdal Medical Corporation v. Ambu, Inc., 877 F.Supp. 255, 258, 34 U.S.P.Q.2d 1140 (D. Md. 1995).

⁴ See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d 1786 (Fed. Cir. 1995), citing In re Patent No. 4,461,759, 16 U.S.P.Q.2d 1883, 1884 (Dep. Ass't Comm'r Pat. 1990) (quoting Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. 977, 982 (D.C. Cir. 1982)), Douglas v. Manbeck, 21 U.S.P.Q.2d 1697, 1700, 1991 U.S. Dist. LEXIS 16404 (E.D. Pa. 1991), aff'd 975 F.2d 869 (Fed. Cir. 1992), and In re Mattullah, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912).

⁵ Haines v. Quigg, 673 F.Supp. 314, 317; 5 U.S.P.Q.2d 1130 (N.D. Id. 1987), citing Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); In re Mattullah, *supra* note 4, at 514; also, Winkler v. Ladd, 221 F.Supp. 550, 553; 138 U.S.P.Q. 666 (D.D.C. 1963).

⁶ See Ray v. Lehman, *supra* note 4, at 609; 37 CFR 1.378(b)(3); MPEP section 1.590 (Aug. 2001).

⁷ From the time the fee was due and payable, until the filing of a grantable § 1.378 petition.

⁸ The patent had already expired on 1/5/02.

Reissue Patent No. RE37,208

The Office notes that:

- (1) According to the PTO assignment records, Targor GMBH is the assignee under the last assignment of the original patent, recorded in the PTO in 1998. The petition represents BASF Corporation as the current assignee of the entire interest in the reissue patent, and consequently, the party responsible for maintaining the original patent and later the reissue patent.
- (2) Based on an alleged telephone conversation with a PTO employee in July of 2001, Hoggarth assumed, without verifying for more than one year, that the requisite fee amount was charged from BASF's deposit account and posted to the instant reissue patent as the second maintenance fee payment.
- (3) The petition has not supplied any evidence supporting the statements made in the Hoggarth Affidavit.

In conclusion, the petition fails to show that Hoggarth, on behalf of BASF in maintaining this patent, has exercised the diligence of a reasonably prudent person in relation to his most important business. Specifically, the petition has not shown that the entire delay in paying this maintenance fee constitutes "unavoidable delay" within the meaning of 37 CFR 1.378(b). The §1.378(b) petition is thus dismissed.

Alternative petition under 37 CFR 1.378(c)

The petition was filed within 24 months of January 4, 2002; authorizes the Office to charge the \$2,020 maintenance fee and the \$1,640 surcharge to Deposit Account No. 02-1201;¹⁰ and states that the delay in paying the fee was unintentional. The §1.378(c) petition is thus granted, and the patent is hereby reinstated as of the mailing date of this decision.

Finally, the practitioner signing the instant petition uses an address different from that in the Office record for this reissue patent. While a copy of the decision is being sent to the practitioner, all future correspondence on this reissue patent will be mailed to the current address-of-record unless the Office is properly instructed otherwise.

If BASF, indeed, is the current assignee of the entire interest in this reissue patent, and wishes to change the correspondence, a proper request should be submitted along with:

-an appropriate statement under 37 CFR 3.73(b), establishing BASF's ownership in the reissue patent to enable BASF to take any action on matters related to this reissue

⁹ See MPEP section 2590 (Aug. 2001), citing In re Patent No. 4,409,763, 7 U.S.P.Q.2d 1798, 1800 (Comm'r Pat. 1988), aff'd *sub nom.*

¹⁰ Counsel authorized the surcharge under 37 CFR 1.20(l)(1), which should have been §1.20(l)(2) for a §1.378(c) petition. A §1.378(c) petition without the requisite surcharge would be dismissed.

¹¹ See 35 U.S.C. 41(c)(1); 37 CFR 1.378(a) (If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but it will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).) (emphasis added); see MPEP 2591 (Aug. 2001) re such intervening rights.

4

Reissue Patent No. RE37,208

patent before the PTO;¹² and
-a copy of the assignment(s), evidencing a chain of title from Targor GMBH to BASF.

The file is being returned to Files Repository.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

cc: Fernando A. Borrego, Esq.
BASF Corporation
1609 Biddle Avenue
Wyandotte, MI 48192

¹² The §3.73(b) statement must be, and must indicate that it is, signed by a person authorized to act on behalf of BASF, e.g., an officer of the corporation.